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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/464,855	12/16/1999	WILLEM BULTHUIS	PHA-23.875	8178

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EXAMINER
D'AGOSTA, STEPHEN M

ART UNIT	PAPER NUMBER
2684	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

	Application No.	Applicant(s)
Office Action Summary	09/464,855	BULTHUIS ET AL.
	Examiner	Art Unit
	Stephen M. D'Agosta	2684

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____ .

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-22* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-22* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

   If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

   a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *6* .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-7, 9, 11, 15-17, 19 and 20 rejected under 35 U.S.C. 103(a) as being

unpatentable over Macor et al. U.S. Patent 5,774,540, and Kowalski U.S. Patent

5,095,503 (hereafter referred to as Macor and Kowalski).

As per **Claims 1 and 15**, which describe an "information processing device with

a user interface" to allow a user to "navigate a set of input options" and "select the

validated input", Macor teaches use of a manipulatable member (eg. Trackball, Joystick)

(C2, L26-45). Specifically, the trackball/joystick allows the user to navigation through

screens of information to get to that action the user wishes to perform (C2, L26-45).

Macor is silent on the unit providing auditory feedback.

Claim 1, which also describes the device's ability to "provide auditory feedback

about which option is selected", reads on Kowalski's cellular telephone which provides

voice-synthesized feedback/output for selected features, options, services, directories,

etc. (C1, L53-58). This allows the user to easily grasp the contents of an item retrieved

or of an operation they are performing. It would be obvious to one skilled in the art to

adapt Macor's system such that it can provide auditory feedback regarding the option

selected so that a person could use it without being required to look at the display (ie. In the dark, while driving, if visually impaired, etc.).

As per **Claim 2**, which describes "navigation via manual input", Macor teaches the use of a trackball (or joystick) that can be depressed to alter information being displayed (C2, L28-39).

As per **Claim 3**, which describes "validation of input via manual input", Macor teaches the use of a depressable trackball or joystick to allows the user to select/validate the information being displayed and/or the operation that they want to perform (C4, L28-30 and/or C4, L37-39).

As per **Claim 4**, which describes "manual input allows for stepping through the set of options", Macor teaches the use of the depressable trackball or joystick to change the information which is shown on the display (C4, L28-30 and C4, L37-39).

As per **Claim 5**, which describes "auditory feedback in a first manner when navigating at a fast speed and in a second manner (different from the first manner) when the user is navigating slowly", Macor teaches a portable telecommunications device (C2, L19-20) but is silent on auditory feedback. Kowalski teaches a cellular phone with synthesized voice feedback as the user scrolls through phone numbers, directories, etc. (C2, L4-26). Kowalski is silent on any correlation between the speed at which a user can scroll and the ability of the device to verbalize output at the same speed (ie. Can the user scroll faster than the unit's ability to voice the item selected, and if so, what happens?).

It would be a primary design consideration (to a person skilled in the art) of any device which can be operated without looking at it to allow the user to know where they are navigating from/to at all times. Hence, auditory feedback must be able to keep up with the speed of the navigation operation and therefore must either throttle the user's ability to navigate too quickly or change the auditory response if too fast (ie. Go from spoken name to clicks). Therefore, it would have been obvious to one skilled in the art to adapt Macor's telecommunications device such that if the user scrolls at one speed (eg. Slowly), the listed item is spoken and if the user scrolls at a second speed (eg. Fast), an audible click is heard thus enabling the user to operate the device without having to look at it but still know where they are.

As per **Claims 6 and 16**, which describes the user "scanning a linear array of options via the navigation input", Macor teaches the use of the trackball/joystick which allow the user to navigate through information/screens/menus (C2, L28-45). Figure 10 shows a "Scroll" bar with "<" and ">" functionality which could be used to navigate up and down a list. Figure 4 shows a menu which can be navigated by manipulating the trackball shown. Figures 7 and 8 show a screen of alphanumeric characters which can be navigated via the trackball shown (These two figures also show "functions" which could be invoked (ie. Edit, delete, exit) via the trackball as well).

A Linear scan, while not defined in the application, is considered to be one that allows the user to proceed from "entry N" to "entry N+1" (or "entry N-1") via the manipulation of the trackball or joystick.

As per **Claims 7 and 17**, which describes the user "scanning a circular array of options via the navigation input", reads on Macor's use of the trackball/joystick which allows the user to navigate through information/screens/menus (C2, L28-45). Figure 10 shows a "Scroll" bar with "<" and ">" functionality which could be used to navigate up and down a list. Figure 4 shows a menu which can be navigated by manipulating the trackball shown. Figures 7 and 8 show a screen of alphanumeric characters which can be navigated via the trackball shown (These two figures also show "functions" which could be invoked (ie. Edit, delete, exit) via the trackball as well).

A Circular scan, while not defined in the application, is considered to be one that allows the user to scroll in a circular fashion, such that when the **end** is reached, the next entry listed is the **first**. Hence the list "wraps" back upon itself (forward or backward). For entries/options listed alphabetically, the entry after "Z" would be "A" and vice versa (if going backwards from "A").

As per **Claim 9**, which describes "a mobile communication apparatus", Macor teaches the use of a portable telecommunications device (C1, L14-15).

As per **Claim 11**, which describes the information processing device in claim 1 as "being a computer" reads on Macor's invention since it contains a microprocessor (C2, L63).

As per **Claim 19**, which describes the device as "being telephone which can store telephone extensions", Macor teaches the "portable telecommunications device" as being a phone since he shows a device/phone (Figure 1) with the name and phone

number of a person on the display (Figures 9 and 10). Macor shows that searching the

phone's database will retrieve a name and phone number (Figure 10 and C5, L45-51).

As per **Claim 20**, which describes the device being "capable of email

communications and the set of options are email addresses", reads on Macor as his

portable telecommunications device (C2, L19-20) having the ability to send/receive

"electronic" transmissions (C3, L47). If the unit can send/receive, then it must have the

ability to store and use email addresses. Macor shows the unit with a "Send Message"

button (Figure #4) and a "Directory" button. He also shows the unit as having received

an electronic message (Figure #8).

Claims 8 and 12 rejected under 35 U.S.C. 103(a) as being unpatentable over

Macor and Kowalski as applied to claim 1 above, and further in view of Ericsson

Corporation Derwent 1999-151852 (hereafter referred to as Macor, Kowalski and

Ericsson).

As per **Claim 8**, which describes an ability to "enable the user to program

memory for storing audio files for auditory feedback while navigating in the set of

options", Macor teaches a portable telecommunications device (C2, L19-20) but is silent

on storing audio files. Ericcson teaches a cell phone which can be adapted so that it

can "store MP3 files and associated play lists" (Reference Title and Abstract). It would

be obvious to one skilled in the art to adapt Macor's cell phone such that it can STORE

(and play) audio/MP3 files while also incorporating "introductory play out" capability

such that the cell phone has added functionality.

As per **Claim 12**, which describes the ability of "an apparatus for playout of music files", reads on Macor and Ericsson as the cell phone having MP3 capability. Macor teaches a portable telecommunications device (C2, L19-20) but is silent on playout of music files. Ericsson teaches a cell phone with extended flash memory that allows the user to store and play audio files (Title and Abstract). Hence it would be obvious to one skilled in the art to modify Macor's device such that it can be used to play audio/MP3 files thus adding fundtionality.

Claim 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Macor and Kowalski as applied to claim 1 above, and further in view of Schwelb et al. U.S. Patent 5,950,123 (hereafter referred to as Macor, Kowalski and Schwelb).

As per **Claim 10**, which describes a "wireless email terminal for operating with an application server for text-to-speech conversion", Macor teaches a device being portable (C1, L48) and having wireless electronic messaging capability (C3, L47) since he shows his invention with a "Send Message" option (Figure 2, top right-hand screen option), an "incoming message indicator" (C3, L75 or Figure 3, note "message" LED indicator on front panel) and a text message being viewable on the display screen (Figure 8, opened door shows "Hi John, Can you help me with this concept? Thanks! Jim Macor x4535"). Macor is silent on the device being able to convert text-to-speech. Schwelb teaches a cellular phone network that allows a user to receive an email message in audible form (eg. Text-to-speech converted) (C1, L35-39). It would be obvious to one skilled in the art to adapt Macor's portable device to allow it to play out an email message in "audible format" thus adding functionality.

Claims 13, 18 and 21 rejected under 35 U.S.C. 103(a) as being unpatentable over Macor and Kowalski as applied to claim 1 (and 15) above, and further in view of Ericsson Corporation DERWENT 1999-151852 and Microsoft Corporation (hereafter referred to as Macor, Kowalski, Ericsson and Microsoft).

As per **Claim 13**, which describes "introductory auditory feedback being a portion of a respective one of the files", Macor teaches a portable telecommunications device (C2, L19-20) but is silent on introductory auditory feedback. Ericsson teaches a cellular phone with MP3 capability (ie. The phone can play MP3/audion files) (Reference Title and Abstract) and Microsoft teaches software (as referenced by the applicant: Page 9, L16-27) which plays a small portion of a song (eg. Introduction) while a user is navigating a list of songs. It would be obvious to one skilled in the art to adapt Macor's device for increased functionality such that it can play MP3/audio files and incorporates software similar to Microsoft's CD Player which would play a brief introduction of each song in memory when a user is attempting to select a song to play.

As per **Claim 18**, which describes the user being able to "program the device with the music that is played during navigation", Macor teaches a portable telecommunications device (C2, L19-20) but is silent on music being played during navigation. Ericsson teaches a cellular phone with MP3 capability (Title and Abstract). Microsoft teaches, per the applicant (Page 9, L16-27), CD Player software which has "a short intro play-out mode to play out only the first portion of each track stored". It would be obvious to one skilled in the art to adapt Macor's device/cell phone for added

functionality such that the user can program memory with audio files snippets that get played out as the user navigates through a set of options (eg. Song list).

As per **Claim 21**, which describes "audio play-out functionality and the set of options are introductory portions audio files", Macor teaches a portable telecommunications device (C2, L19-20), but is silent of audio playout functionality. Ericsson teaches a cell phone with MP3/audio playing capability (Reference Title and Abstract). Microsoft teaches, per the applicant (Pg. 9, L16-27), that CD Player software plays a brief introduction of an audio file (from a list of files) as a user peruses the list. It would be obvious to one skilled in the art to adapt Macor's device to include Ericsson's MP3-storing/playing functionality along with software that is similar to Microsoft's play-out introduction for increased functionality.

Claims 14 and 22 rejected under 35 U.S.C. 103(a) as being unpatentable over Macor and Kowalski as applied to claim 1 (and 15) above, and further in view of Argyroudis et al. U.S. Patent 5,748,104 (hereafter referred to as Macor, Kowalski and Argyroudis).

As per **Claim 14**, which describes the device as being a "remote control for consumer appliances", Macor teaches a portable telecommunications device (C2, L19-20) but is silent on it being able to remotely control appliances. Argyroudis teaches a mobile/cell phone remotely activating/deactivating an appliance (C6, L44-47 and Figure 1). It would be obvious to one skilled in the art to adapt Macor's device such that it can remotely activate/deactivate an appliance thus adding further functionality.

As per **Claim 22**, which describes a method whereby the device is "a remote control device and the options are control codes for consumer appliances", Macor teaches a portable telecommunications device (C2, L19-20) but is silent on it using control codes. Argyroudis teaches that one could send "control messages from a conventional subscriber station" such as a cell phone to "remotely activate and deactivate an appliance" (C6, L44-47).

The applicant describes his remote control device as being able to do more than just turn on/off an appliance. Hence, it would be obvious to one skilled in the art to modify Macor's device such that it can utilize appliance control codes for enhanced functionality.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

1. Takanori Nishiyama et al. U.S. Patent 5,436,954 discloses a rotary selector on a portable radio telephone.

2. Lee et al. U.S. Patent 6,141,008 discloses a personal mobility system which utilizes email addresses.

3. Van Der Meulen U.S Patent 2000-105936 discloses a virtual jukebox.

4. Dubus U.S. Patent 4,731,811 discloses a mobile telephone for motor vehicles with keywords stored in memory..

5. Ahlberg et al. U.S. Patent 5,758,295 which discloses a man-machine interface for cellular mobile phones.

6. Yamagishi et al. U.S. Patent 6,178,338 which discloses a communication terminal apparatus for selecting options using a dial shuttle.

7. Zou et al. U.S. Patent 6,246,983 discloses a text-to-speech email reader.

8. Davidson et al. U.S. Patent 5,774,540 which discloses a hierarchical menu screen interface for displaying and accessing telephone terminal features.

9. Charlier et al. U.S. Patent 6,192,253 which discloses a multi-functional radiotelephone.

10. Kikinis et al. U.S. Patent 5,812,870 which discloses a personal organizer with interface for recording digital voice files.

11. Borgstahl et al. U.S. Patent 5,909,183 which discloses an interactive appliance remote controller system/method.

12. Kwatinetz U.S. Patent 5,495,566 which discloses a variable method for window scrolling.

13. Seidensticker, Jr. et al. U.S. Patent 6,128,012 which discloses a user interface for a portable data management device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 703-306-5426. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Hunter can be reached on 703-308-6732. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is 703-306-

0377.

SMD
November 20, 2001

DANIEL HUNTER
SUPERVISORY PATENT EXAMINER
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